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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,929	08/31/2001	Kevin P. Baker	P2548P1C21	2450

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BRINKS, HOFER, GILSON & LIONE
PO BOX 10395
Chicago, IL 60611-5599

EXAMINER

VOGEL, NANCY TREPTOW

ART UNIT	PAPER NUMBER
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1636

MAIL DATE	DELIVERY MODE
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09/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/944,929	Applicant(s) BAKER ET AL.	
	Examiner NANCY VOGEL	Art Unit 1636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27-34 and 38-41 is/are allowed.
- 6) ☒ Claim(s) 35-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 35-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification as originally filed does not provide support for the invention as now claimed: "wherein said isolated nucleic acid encodes a polypeptide that inhibits suppression of an immune response in a mixed lymphocyte reaction assay" (claim 35).

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This a new matter rejection. The specification does not provide sufficient blazemarks nor direction for the instant methods encompassing the above-mentioned limitations, as currently recited. The instant claims now recite limitations which were not clearly disclosed in the specification as-filed, and now change the scope of the instant disclosure as-filed. The specification at page 141 discloses that protein PRO361 tests positive in an assay for inhibition of proliferation of stimulated T-lymphocytes in the MLR reaction assay. There is no disclosure that the protein acts as an inhibitor of suppression of an immune response in an MLR reaction assay. This limitation recited in the present claims, which did not appear in the specification, as filed, introduce new concepts and violate the description requirement of the first paragraph of 35 U.S.C. 112.

Claims 35-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims are drawn to nucleic acids which hybridize under high stringency conditions to the nucleic acid sequence encoding the polypeptide shown in Fig. 32, which is SEQ ID NO:83, or derivatives thereof, or SEQ ID NO:82, and which encode a polypeptide that inhibits suppression of an immune response in a mixed lymphocyte reaction assay. The claims do not require that the nucleic acid possess any particular conserved structure, or that it encode a polypeptide that possesses any particular

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conserved structure. Thus, the claims are drawn to a species of nucleic acids which hybridize to a particular nucleic acid molecule, and which retain the recited activity.

To provide an adequate written description and evidence of possession of a claimed genus, the specification must provide sufficient distinguishing identifying characteristics of the genus. The factors to be considered include disclosure of complete or partial structure, physical and/or chemical properties, functional characteristics, structure/function correlation, methods of making the claimed product, or any combination thereof. In this case, the only factors present in the claim is a partial structure in the form of a recitation of ability to hybridize to the disclosed nucleic acid, and a required functional characteristic. There is no analysis in the specification showing regions or domains which must be conserved, or which regions or domains may tolerate conservative or other changes, and have the recited activity. There is nothing in the prior art regarding the encoded protein which would indicate which regions or domains would tolerate changes, without loss of the recited activity. The disclosure is not deemed to be descriptive of the complete structure of a representative number of species encompassed by the claims as one of skill in the art cannot envision which of the very numerous members of the genus of molecules which would hybridize under stringent conditions to the disclosed molecule, would encode a protein with the recited function. It is noted that the specification does not even disclose that the molecule encoded by the disclosed nucleic acid, i.e. SEQ ID NO:83 encoded by SEQ ID NO:82, possesses the recited activity of "a polypeptide that inhibits suppression of an immune response in a MRL reaction". The specification discloses that the protein of

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SEQ ID NO:83 tests positive as a suppressor of proliferation of T lymphocytes, which is the opposite effect as recited in the claims in question. Therefore, the specification does not describe the claimed genus of molecules in such full, clear, concise and exact terms so as to indicate that Applicant has possession of the method at the time of filing the present application. Thus, the written description requirement has not been satisfied.

Response to Amendment

The Declaration filed on 6/24/08 under 37 CFR 1.131 is sufficient to overcome the rejection under 35 USC 112 p.1 based on lack of enablement for claims 27-34 and 38-41. The data presented in the Declaration provides support for the assertion that the protein encoded by the nucleic acid whose sequence is shown in SEQ ID NO:82, or other nucleic acids which encode said protein, decreases the response of the MLR, demonstrating immunosuppression in vitro.

Claims 27-34 and 38-41 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANCY VOGEL whose telephone number is (571)272-0780. The examiner can normally be reached on 7:00 - 3:30, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach can be reached on (571) 272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/NANCY VOGEL/
Primary Examiner, Art Unit 1636

NV
9/3/08